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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,967	11/21/2001	Travis J. Parry	10008078-1	1662

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HEWLETT-PACKARD COMPANY  
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EXAMINER	
SCUDERI, PHILIP S	
ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/989,967		PARRY, TRAVIS J.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Philip S. Scuderi		2153	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

This Office action is in response to applicant's amendment filed on 13 June 2006.

### *Response to Arguments*

Applicant indicated that it is assumed that since a specific subsection of 35 U.S.C. 102 was not cited in the rejection of claims 1-4, 6-8, and 11 as being anticipated by the Admitted Prior Art that the rejection was under 35 U.S.C. 102(b) (remarks, page 6). To be clear, Admitted Prior Art does not need to qualify as prior art under the statutory categories of 35 U.S.C. 102 because admissions are available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003).

Applicant's arguments that the Admitted Prior Art does not teach a controller that is internal to an imaging device and is adapted to store a list of other imaging device network addresses have been fully considered and are persuasive (remarks, pages 6-8). Therefore, the corresponding rejections have been withdrawn.

Applicant's arguments that the U.S. Patent No. 6,965,931 to Helms does not teach an imaging device that is an internal image generator of an imaging device that produces a hard copy on the appropriate media have been fully considered and are persuasive (remarks, pages 8-9). Therefore, the corresponding rejections have been withdrawn.

Applicant's arguments that the U.S. Publication No. 2003/0055874 to Simpson et al. does not teach an imaging device that is an internal image generator of an imaging device that produces a

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hard copy on the appropriate media have been fully considered and are persuasive (remarks, pages 10-11). Therefore, the corresponding rejections have been withdrawn.

Although applicant's arguments are persuasive, new grounds of rejection are made below in view of newly discovered 35 USC 112 issues and newly discovered prior art.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-11, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 refers to "the imaging device" in lines 4 and 7. It is unclear whether these limitations are referring to the imaging device introduced in line 1 or the imaging device introduced in lines 2-3. The examiner's best understanding is that the imaging devices introduced in lines 1 and 2-3 were intended to be the same imaging device. The examiner will treat the claims on the merits as best understood.

Claims 2-11 depend from claim 1 and are rejected for the same reasons.

Claims 13 and 14 are directed to a "computer usable medium" for execution by a processor to "perform a method" comprising certain steps. Computer usable mediums are generally considered "manufactures" under 35 USC 101. Methods are generally considered "processes" under 35 USC 101. It is unclear which statutory category of invention under 35 USC 101 these claims fall under.

### ***Claim Objections***

Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 14 further limits the “method of claim 13”, but does not require the computer-usable medium of claim 13. Therefore, claim 14 fails the infringement test for proper dependent claims. See MPEP 608.01(n).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-11 and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,021,429 to Danknick (“Danknick”).**

As per claim 1, Danknick teaches an imaging device comprising:

an image generator (print engine), wherein the image generator is a print engine internal to an imaging device (printer 17) (figure 2; column 5, line 45 – column 6, line 49);

a network interface (30), wherein the network interface is adapted to couple the imaging device (print engine) to a network (LAN) (figure 2; column 5, line 45 – column 6, line 49); and

a controller (NEB) coupled to the network interface (30) and the image generator (print engine), wherein the controller is internal to the imaging device (printer 17) and is adapted to store a list of other imaging device network addresses (addresses of printers, copiers, fax machines, etc.) (column 7, line 45 – column 8, line 28).

As per claim 2, Danknick teaches the imaging device of claim 1, wherein the list of other imaging device network addresses further comprises a list of other imaging device network addresses, where the other imaging devices are similar to the imaging device (column 7, line 45 – column 8, line 28).

As per claim 3, Danknick teaches the imaging device of claim 1, wherein the list of other imaging device network addresses further comprises imaging device supplemental information (column 7, line 45 – column 8, line 28).

As per claim 4, Danknick teaches the imaging device of claim 1, wherein the controller (NEB) is adapted to store a list of other network addresses in a register (column 7, line 45 – column 8, line 28).

As per claim 5, Danknick teaches the imaging device of claim 1, wherein the controller (NEB) further comprises an embedded webserver (column 8, lines 29-64).

As per claim 6, Danknick teaches the imaging device of claim 1, wherein the list of other network addresses is a sequential list (column 7, line 45 – column 8, line 28).

As per claim 7, Danknick teaches the imaging device of claim 1, wherein the controller (NEB) is adapted to discover the list of other network addresses (column 9, line 50 – column 11, line 67).

As per claim 8, Danknick teaches the imaging device of claim 7, wherein discovering the list of other network addresses further comprises pinging network addresses (column 10, lines 25-45).

As per claim 9, Danknick teaches the imaging device of claim 7, wherein discovering the list of other network addresses is scheduled to occur at specific times (expiration times) (column 10, lines 25-45).

As per claim 10, Danknick teaches the imaging device of claim 7, wherein a history list of previously valid network addresses is utilized in discovering the list of other network addresses (column 10, lines 25-45).

As per claim 11, Danknick teaches the imaging device of claim 1, wherein a network device at a network address notifies the imaging device when the network device comes online (imaging devices operating as slaves) (column 12, line 1 – column 13, line 4).

As per claim 13, Danknick teaches a computer-usable medium having computer readable instructions stored thereon for execution by a processor of an imaging device to perform a method comprising:

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determining a list of network addresses for other imaging devices similar to a first imaging device, wherein the first imaging device contains a print engine (column 5, line 45 – column 6, line 49);

storing the list of network addresses on the first imaging device (column 5, line 45 – column 6, line 49); and

communicating with the other similar imaging devices by referring to the list of network addresses for the other imaging devices (column 5, line 45 – column 6, line 49).

As per claim 14, Danknick teaches the method of claim 13, wherein determining the list of other network addresses for other imaging devices similar to the first imaging device further comprises discovering the network addresses for other imaging devices similar to the first imaging device (column 9, line 50 – column 11, line 67).

As per claim 15, Danknick teaches a method of operating an imaging device, the method comprising:

determining a list of network addresses for other imaging devices similar to a first imaging device, wherein the first imaging device contains a print engine (column 5, line 45 – column 6, line 49);

storing the list of network addresses on the first imaging device (column 5, line 45 – column 6, line 49); and

referring to the list of network addresses of other imaging devices for communication between imaging devices (column 5, line 45 – column 6, line 49).



As per claim 16, Danknick teaches the method of claim 15, wherein determining the list of network addresses for other imaging devices similar to the first imaging device further comprises discovering the network addresses for other imaging devices similar to the first imaging device (column 5, line 45 – column 6, line 49).

As per claim 17, Danknick teaches the method of claim 16, wherein discovering the list of other network addresses further comprises pinging network addresses (column 10, lines 25-45).

As per claim 18, Danknick teaches the method of claim 15, further comprising:  
notifying the first imaging device when an imaging device associated with a network address of the list of network addresses for other imaging devices comes online (imaging devices operating as slaves) (column 12, line 1 – column 13, line 4).

As per claim 19, Danknick teaches the method of claim 16, further comprising storing additional information on each imaging device associated with the list of network addresses of other similar imaging devices wherein the additional information is imaging device supplemental information (column 7, line 45 – column 8, line 28).

As per claim 20, Danknick teaches the method of claim 15, further comprising:  
directing the communication between the first imaging device and other similar imaging devices (controlling the NEB) with a webserver embedded in the first imaging device (column 8, lines 29-64).

*Conclusion*


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP Publication No. 843,440 comprises the same disclosure as US Patent No. 6,021,429.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PS

  
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